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EXAMINER

SCHOPFER, KENNETH G

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/977,125

Applicant(s)

LACHANCE, CAROL  
STONEBROOK

Examiner

Kenneth G Schopfer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by

"such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "a mixture of natural and/or synthetic fiber staples", and the claim also recites "preferably Pellon" which is the narrower statement of the range/limitation.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2 and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (USPN 5507794).

8. Referring to claim 2, Allen teaches all of the limitations of this claim except for the ice patch and jacket being disc shaped, the ice patch being made of plastic-vinyl material, and the decorative indicia coupled to the exterior panel of the jacket. Allen teaches an ice patch 40 made of a plastic film envelope with a freezable gel inside (column 4, lines 9-25) and a jacket 20 composed of natural or synthetic cloth having a pocket for receiving the ice patch (column 3, lines 55-60). Also, Allen teaches a support member 10 for carrying the pouches and applying them to a user. It would have been obvious to one of ordinary skill in the art at the time of

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invention that the use of a circular shape, plastic-vinyl material, and decorative indicia as in the claims represent unpatentable design choices over the ice patch and jacket of Allen that would not change the ability of the device to provide therapeutic cooling to a user.

9. Referring to claim 5, Allen teaches all of the limitations of this claim as described above except for the indicia on one surface of the ice patch. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of indicia on the ice patch as in the claims represents an unpatentable design choice over the ice patch of Allen that would not change the functionality of the device.

10. Referring to claim 6, Allen teaches all of the limitations of this claim as described above except for the jacket being made of Pellon. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of Pellon as in the claims represents an unpatentable design choice over the use of the cloth in Allen that would not change the functionality of the device.

11. Referring to claims 7-13, Allen teaches all of the limitations of these claims as described above except for the decorative indicia on the jacket. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of decorative indicia including a teddy bear, volley ball, tennis ball, hockey stick, baseball, flower, and lady bug as in the claims represents an unpatentable design choice over the jacket of Allen that would not change the functionality of the device.

12. Claims 1, 3, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (USPN 5507794) in view of Thomas et al. (USPN 5215080).

13. Referring to claim 1, Allen teaches all of the limitations of this claim except the ice patch and jacket being disc shaped; the ice patch being made of plastic-vinyl material; the decorative indicia coupled to the exterior panel of the jacket; the carrying case; and the tie. Allen teaches an ice patch 40 made of a plastic film envelope with a freezable gel inside (column 4, lines 9-25) and a jacket 20 composed of natural or synthetic cloth having a pocket for receiving the ice patch (column 3, lines 55-60). Also, Allen teaches a support member 10 for carrying the pouches and applying them to a user. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of a circular shape, plastic-vinyl material, and decorative indicia as in the claims represent unpatentable design choices over the ice patch and jacket of Allen that would not change the ability of the device to provide therapeutic cooling to a user.

Thomas et al. teach a therapeutic cold pack system including a carrying case for carrying ice packs made of a heavy cloth material with front and back walls where the back wall extends into a flap for closing the case. Also, stitching and hook and loop fastening strips form two pockets in the case for holding two ice packs. It would have been obvious to one of ordinary skill in the art at the time of invention to use a carrying case as in Thomas et al. with the device of Allen to provide a suitable means for transporting the device and attaching the device to a user. Further, it would have been obvious to one of ordinary skill in the art at the time of invention that the use of a tie to close the carrying case as in the claims represents an unpatentable design choice over the hook and loop strips in the combined device of Allen and Thomas et al. that would not change the functionality of the device.

14. Referring to claim 3, Allen teaches all of the limitations of this claim as described above except for the carrying case. Thomas et al. teach a therapeutic cold pack system including a

carrying case for carrying ice packs made of a heavy cloth material with front and back walls where the back wall extends into a flap for closing the case. Also, stitching and hook and loop fastening strips form two pockets in the case for holding two ice packs. It would have been obvious to one of ordinary skill in the art at the time of invention to use a carrying case as in Thomas et al. with the device of Allen to provide a suitable means for transporting the device and attaching the device to a user.

15. Referring to claim 4, Allen and Thomas et al. teach all of the limitations of this claim as described above except for the tie for closing the device. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of a tie to close the carrying case as in the claims represents an unpatentable design choice over the hook and loop strips in the combined device of Allen and Thomas et al. that would not change the functionality of the device.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth G Schopfer whose telephone number is 703-305-2649. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

KS

KS  
October 29, 2002

A handwritten signature in black ink, appearing to read 'Linda C. M. Dvorak', with a large, stylized loop at the end.

LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700